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EXAMINER

WEBB, J

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Please find below and/or attached an Office communication concerning this application or proceeding.

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Paper No. 36

Application Number: 09/107,643

Filing Date: June 30, 1998

Appellant(s): TRACY, RHONDA

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Edward D. Manzo  
For Appellant

EXAMINER'S ANSWER

This is in response to appellant's brief on appeal filed 9/4/01.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

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**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is correct.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

**(7) *Grouping of Claims***

Appellant's brief includes a statement that claims 7-40 do not stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8).

**(8) *ClaimsAppealed***

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) *Prior Art of Record***

4,816,025	Foreman	3-1989
3,572,342	Lindquist et al.	3-1971
3,461,872	McConnel et al.	8-1969

**(10) *Grounds of Rejection***

The following ground(s) of rejection are applicable to the appealed claims:

Claims 7-8, 11-13, 15-16, 18, 21, 23-26, 28, 31, 33-36, and 38 are unpatentable under 35

U.S.C. 102(b) as being anticipated by Foreman (US 4,816,025).

With respect to Claim 7: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic outer layer (column 8, lines 43-47) and a liquid absorbent layer (column 7, lines 41-56). Foreman discloses a soft padding member (see element 262, Figure 3; column 5, lines 56-58) located along at least one of the waist band portions, adjacent to the outer layer edge (the plastic layer edge), the soft padding member being distinct from the body portion layer, the soft padding member being located between the diaper wearer and the plastic layer edge when being worn by the wearer.

With respect to Claim 8: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic outer layer (column 8, lines 43-47) and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses a strip of non-abrasive material (see element 262 shown in Figures 3, and column 5, lines 56-58) located along at least one of the waist band portions, adjacent to the outer layer edge (the plastic layer edge), the strip being distinct from the body portion layer, the strip providing a cushion between the diaper wearer and the outer layer (plastic layer) edge when being worn by the wearer.

With respect to Claims 11, 21 and 25: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic bottom sheet 52, a topsheet (40), and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses the use of a horizontally oriented strip (262) being located in the waistband of the diaper (see Figure 1 and 3), the strip being distinct from the

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body portion layer, substantially rectangular in shape, and the strip being located between the wearer and the plastic edge being capable of contacting the skin of the wearer during use.

With respect to Claim 12, 13 and 23: Foreman discloses the strip being a soft padding member (column 5, lines 56-68), which provides cushion between the diaper wearer and the outer layer (plastic layer).

With respect to Claims 15-16, 25-26, and 28: Foreman discloses the strip being adjacent to the outer edge (the plastic edge), is parallel to the waist band (Figure 1) and is provided to be a barrier against leaks (column 10, lines 54-68).

With respect to Claim 24: Foreman disclose the strip (262) providing a thickness between the outer cover (plastic payer) and the wearer. As seen in Figure 1 and 3, the strip 262 is located between the wearer and the plastic layer, and has thickness associated with it, therefore the strip is considered to provide a discrete thickness between the plastic layer and the wearer.

With respect to Claim 31: Foreman discloses a standard hourglass shape diaper (Figure 1) having a plastic bottom sheet (52), a topsheet (40), and a liquid absorbent layer (column 7, lines 41-56). Foreman also discloses the use of vertically oriented strips (62) being located at the leg hole of the diaper (see Figure 1 and 2), the strip being distinct from the body portion layer, and the strip being located between the wearer and the plastic edge.

With respect to Claim 32 and 33: Foreman discloses the strip being a soft padding member, which provides cushion between the diaper wearer and the outer layer (plastic layer). The barrier flaps located at the leg openings, and the barrier flap located at the waist opening, are configured the same and made from the same material. Foreman discloses the strip at the waist

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opening to be a padding member (column 5, lines 55-60). Therefore the examiner considers the barrier cuff at the leg opening to also be a padding member which provides cushion.

With respect to Claim 35, 36 and 38: Foreman discloses the strip being adjacent to the outer edge (the plastic edge), is parallel to the leg openings (Figure 1) and is provided to be a barrier against leaks (column 10, lines 54-68).

It is also noted that Webster's dictionary's definition of soft is something that is easily, cut, worked, or molded, or something that yields readily to pressure or weight. The barrier cuffs disclosed by Foreman are made readily conform to the general shape and contours of the body (column 10, lines 57-62), and therefore yields readily to pressure and therefore is soft.

To the extent that the applicant may argue that the cuff of Foreman is not a "soft padding member" the following rejection is additionally being made.

Claims 7, 12, and 32 are unpatentable under 35 U.S.C. 103(a) as being unpatentable over Foreman (US 4,816,025) in view of Lindquist (US 3,572,342).

Foreman, as described above, fails to teach the use of a "padding member". Lindquist teaches in the same field of endeavor to provide padding elements (37 and 38 for the waist, 35 and 36 for the legs) made of foam applied along the portion of the diaper at which seepage of fluids is not desired along the upper surface.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the upper surface of barrier cuffs 62 and 262 of Foreman with padding elements made of foam, as disclosed by Lindquist) in order to retard fluid. (See column 1, lines 15-20 of Lindquist)

Claims 7-40 are unpatentable under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over McConnell et al. (US 3,461,872).

With respect to Claims 7, 8, 11-13, 15-17, 18-21, 23, 25-33, and 35-40 : McConnell discloses a diaper retaining garment (Figure 1) including an absorbent pad (26 and 27)(Figures 5 and 6). The body includes two enlarged end portions, a narrowed intermediate portion, a waist band portion a waist band portion at leach end, and two leg openings. The garment further includes a liquid absorbent layer (26), a topsheet (27), a plastic backsheets layer (10) having an edge at the edge of the diaper (the body portion, 10, of a flexible polymeric cellular material, an open celled foam such as polyurethane is a plastic layer, see column 4, lines 15-20) and a soft padding member (which is also a non-abrasive strip, see element 22 in figures) located along at least one of the waist band portions and the leg openings adjacent and parallel to the plastic edge, so that the soft (non-abrasive) substance is located between the diaper wearer and the plastic layer edge, such that the diaper presents a soft (non-abrasive) surface at the waistband portion and the leg openings despite the plastic edge. McConnell discloses that the padding member is a distinct piece of material that is made from woven fabric or scrim (column 3, lines 30-39). Scrim is a piece of cotton material, and the examiner considers the strips made of cotton to be a soft padding member that can be used as a cushion. Cotton is an absorbent material, and therefore fully capable of being used as a barrier against leaks. The strips are horizontally oriented and generally rectangular in shape (see Figures 1 and 2).

McConnell discloses:

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The elasticized edges 11, 12, 18 and 19, are preferably covered by fabric outer strip 22 to prevent contact of the wearer with the elastic material forming strip 1. This strip 22 is sewn on along with the elasticized strip 21 and forms an envelope around it. The details of this construction feature can clearly be seen from Figure 2. The material forming the outer strip 22 may comprise any type of flexible material, but is preferably a woven fabric or scrim." (column 3, lines 30-39)

The outer strip 22 wraps around the elastic (21) and the body (10), this it inherently presents a soft surface or a non-abrasive surface at the waistband portion. According to the Webster's Dictionary "scrim" is usually a cotton fabric. Also, McConnell states the elasticized edges are covered by a fabric outer strip 22 to prevent contact of the wearer with the elastic material, this it is inherently a soft material. If it is not inherent, that the material is soft and non-abrasive, then it would have been obvious to one of ordinary skill in the art at the time the invention was made because it is well recognized that babies skin is soft and easily irritated. Why else would McConnell cover the elastic strip with a fabric to prevent the contact of the wearer with the elastic. One of ordinary skill in the art would not cover an elastic with a hard or abrasive material as it defeats the purpose of covering it.

With respect to Claims 9, 10, 14, 22 and 34: McConnell discloses the strip of soft padding member extends from the inside to the outside of the diaper (see Figure 2), thereby capable of softening the edge of effect of the plastic edge on the wearer.

With respect to Claim 24: McConnell disclose the strip (22) providing a thickness between the outer cover (plastic payer) and the wearer. As seen in Figure 1, 2 and 6 the strip 22

is located between the wearer and the plastic layer, and has thickness associated with it, therefore the strip is considered to provide a discrete thickness between the plastic layer and the wearer. Additionally, it is noted that applicant's declaration states that the cotton around the waistline and leg lines of the diaper is a very fine, small layer of cotton, which would be very similar, but not exactly the same as that of a gauze pad or the inside of a gauze pad. McConnell discloses the use of a "woven fabric or scrim" which is easily the same thing.

Claims 11 and 12 are unpatentable under 35 U.S.C. 101 because there exists a positive recitation of a human and/or human anatomy as part of the claimed invention. The phrase "contacts the skin of the wearer" includes the skin of the wearer as part of the claim. The examiner suggests the phrase "is capable of contacting the skin of the wearer" or "is provided to contact the skin of the wearer".

#### ***(II) Response to Argument***

With respect to Appellant's argument that appellant is entitled to the benefit of the 1987 filing date: a patent application is entitled to the benefit of the filing date of an earlier filed application, if the disclosure of the earlier application provides support for the claims of the later application, a design application provides support for structural claims and does not provide support for material claims. One of ordinary skill in the art at the time the invention was made would not be able to look at a drawing and determine what material the article is made out of, therefore the application does not provide support for the strip being a soft padding material, the strip being non-abrasive, or the diaper's outer cover being plastic. Therefore the newly added

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claims 11-40, as well as the old claims 7-10, do not receive the benefit of the 1987 filing date, but instead have an effective filing date of April 30, 1990.

With regards to appellant's statement that the examiner grouped all claims together for the benefit of the priority date of the design patent: the examiner has stated that not only was "soft" not disclosed in the design patent, but "plastic" was not disclosed either. All claims contained the word soft or the word plastic, and therefore all claims did not receive the earlier filing date.

With respect to cited applicable case law: the case law states that a prior application does not have to describe exactly the subject matter claimed and the appellant can rely on a design application if the statutory conditions are met, however for the present application one of ordinary skill in the art cannot clearly and unambiguously determine what materials the article in the design patent are made of. It is the examiner's position that drawings can determine structural limitations, but limitations dealing with the material used cannot be determined by the drawings.

With regards to the two declarations made of record: the appellant has stated, in the declarations, that one of ordinary skill in the art would be able to determine the material used, however at the time the design patent was filed, the inventor may have known what material she wanted the article to be, however the declarations do not prove that one of ordinary skill in the art would have known that the drawings showed that the padding member is soft, or that the outercover is plastic.

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With regards to appellants arguments that Foreman (4,816,025) is not available as a 102

(b) reference: Appellant has not received the benefit of the design patent filing date, therefore Foreman is a 102(b) reference and cannot be sworn behind.

With regards to appellants arguments that the Foreman reference does not apply to the claims: Foreman discloses the use of a barrier cuff (which the examiner considers to be the soft padding member) having a soft non-jagged edge. The examiner considers the fact that if the edge is soft and non-jagged, then the cuff is soft, and the cuff is placed between the wearer and the waist of the diaper, so the examiner considers this to be a form of padding, and it is a member of the diaper. The appellant claims that the member is made from a material that is formed from a soft substance, Foreman discloses that the edge of the strip is soft, therefore the examiner considers the strip to be made from a soft substance.

With regards to appellant statement that Claims 7, 12, and 32 define patentably over Foreman in view of Lindquist (3,572,342): Lindquist clearly describes the foam strips running along both legs and both waist openings, see rejection above. In fact, the only figure where reference numerals 37 and 38 are located, is the figure in where it clearly shows that there are two sets of foam strips, one set in the waist opening, and one set in the leg openings. The reference Lindquist provides suggestion and provides motivation to combine the two references by saying “placing the hydrophobic strips along each side of the diaper on the surface which is adjacent the child when the diaper is in place”. The barrier cuffs of Foreman are adjacent the skin of the wearer, therefore it would have been obvious to combine Foreman with Lindquist.

With regards to appellant's statement that claims 7-40 are neither anticipated nor obvious under McConnel et al. (3,461,872): McConnell discloses the plastic retaining garment with an

absorbent pad located inside the garment. In Figure 6, there exist the plastic retaining garment, and the absorbent pad, with the topsheet placed in side. Although the outer plastic cover is reusable, it is fully capable of being disposed, and the inside pad is also disposable after one use. Therefore the examiner considers McConnell to teach the use of a disposable diaper, with a plastic backsheet, a topsheet and an absorbent core located there between (see figure 6).

With respect to appellant's argument that the PTO Board of Patent Appeals and Interference has already stated McConnell was deficient: The PTO BPAI decision was not for this case, and therefore the BPAI has not considered the McConnell reference as it is now being applied. McConnell does disclose a plastic layer extending to the edge (see Figure 2, column 4, lines 15-17). Webster's II New Riverside Dictionary defines plastic as "adjective-capable of being formed or shaped" and "noun-any various complex organic compounds produced by polymerization, capable of being molded, extruded, cast into various shapes and films, or drawn into filaments used as textile fibers", McConnell discloses the outer cover being a flexible polymeric cellular material being made from a polyurethane foam (which is an organic compound that is polymerized). As shown in Figure 2, there is the elastic strip 21, covered by the padding 22, and the plastic outer cover is located at the edge. Figure 2 is a cross section of the middle of the diaper extending from one leg opening to the other, however Figure 1 shows no difference in structure at the leg openings and the waist opening, therefore the examiner considers there to be a plastic edge that is located at the edge of the outer cover in the waist region.

With respect to appellant's argument that Claims 11 and 12 do not recite a human nor human anatomy as part of the claimed invention: the claims state "the strip contacts the skin of

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the wearer", therefore the article must be in use in order to satisfy this limitation, the article as it is presently claimed cannot stand on its own without the wearer being present. By changing the word "contacts" into "is capable of contacting" or "is provided to contact" it states that the article is fully capable of performing his function, but recites only limitations of the article, the wearer need not be present.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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October 30, 2001

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**Attachment for PTO-948 (Rev. 03/01, or earlier)**  
**6/18/01**

**The below text replaces the pre-printed text under the heading, "Information on How to Effect Drawing Changes," on the back of the PTO-948 (Rev. 03/01, or earlier) form.**

**INFORMATION ON HOW TO EFFECT DRAWING CHANGES**

**1. Correction of Informalities -- 37 CFR 1.85**

New corrected drawings must be filed with the changes incorporated therein. Identifying indicia, if provided, should include the title of the invention, inventor's name, and application number, or docket number (if any) if an application number has not been assigned to the application. If this information is provided, it must be placed on the front of each sheet and centered within the top margin. If corrected drawings are required in a Notice of Allowability (PTO-37), the new drawings **MUST** be filed within the **THREE MONTH** shortened statutory period set for reply in the Notice of Allowability. Extensions of time may **NOT** be obtained under the provisions of 37 CFR 1.136(a) or (b) for filing the corrected drawings after the mailing of a Notice of Allowability. The drawings should be filed as a separate paper with a transmittal letter addressed to the Official Draftsperson.

**2. Corrections other than Informalities Noted by Draftsperson on form PTO-948.**

All changes to the drawings, other than informalities noted by the Draftsperson, **MUST** be made in the same manner as above except that, normally, a highlighted (preferably red ink) sketch of the changes to be incorporated into the new drawings **MUST** be approved by the examiner before the application will be allowed. No changes will be permitted to be made other than correction of informalities, unless the examiner has approved the proposed changes.

**Timing of Corrections**

Applicant is required to submit the drawing corrections within the time period set in the attached Office communication. See 37 CFR 1.85(a).

Failure to take corrective action within the set period will result in **ABANDONMENT** of the application.